

REMARKS

Claims 16 to 24 are added, and therefore claims 7 to 24 are now pending and being considered in the present application.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is therefore respectfully requested.

Claims 7 to 8 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,700,020 to Michaels-Krohn et al., ("MK").

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

It is respectfully submitted that that the anticipation rejections should be withdrawn because the MK reference does not identically disclose (or even suggest) all of the features of claim 7. In particular, claim 7 includes the features of a *first data modification device* located on the *sender side and a second data modification device* located on the *receiver side*, in which the first data modification device and the second data modification device each have the *same transmission function* effecting a modification of *input data into output data* and are connected to the data transmission path.

As to the Office Action conclusory assertions as to cited column 7, lines 13 to 26, and column 8, lines 45-62, of the MK reference, the Office Action does not explain -- and it is not readily apparent -- how the cited sections identically disclose the features of the claimed subject matter. Indeed, the Office Action does not even identify what it considers a first data modification device, a second modification device, the sender side, or the receiver side, as provided for in the context of the presently claimed subject matter.

Instead, the Office Action merely cites the above claimed subject matter and conclusorily asserts that certain paragraphs of the MK reference somehow discloses it without providing any supporting explanation or rationale. The MPEP at § 706 specifically provides that the “goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.”

Furthermore, MPEP § 707.05 specifically states that “[d]uring the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims,” and that when such prior art is cited, its pertinence should be explained.” Finally, MPEP § 707 states that “when considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included.” A conclusory anticipation rejection really amounts to little more than an omnibus rejection which contravenes the Office’s procedures.

It is respectfully submitted that any review of the of the MK reference makes clear that the above highlighted features are not identically disclosed, nor suggested. To the extent that the Office Action contends that the “modifying” in the cited sections of the MK reference corresponds to the “modification device” of the claimed subject matter, it is respectfully submitted that this contention is not supported by the cited sections.

Indeed, the MK reference makes plain that the “modifying” of MK concerns a transmitter being supplied with information relating to the *reception of the transmitted signal*. Nothing in the MK suggests that it is “effecting a modification of input data into output data”, as provided for in the context of claim 7. In this regard, MK states that “as a result of this *modifying*, the transmitter is supplied with information relating to the *reception of the transmitted data signal block*. For example, the faultless transmission of a data signal block can be indicated by an *acknowledgement signal modified* in a certain way.” (MK, column 7, lines 21 to 26.)

Accordingly, a modification, let alone two separate modification devices, each having the same transmission function effecting a modification of input data into output data and are connected to the data transmission path, as provided for in the context of claim 7, is not identically disclosed (or even suggested), so that claim 7 is allowable.

Still further, claim 7 includes the additional features of a *comparator located on the receiver side* and connected to the data transmission path and the *second data modification device*, in which the *comparator activates the enabling device when the output data of the first data modification device and the second modification device are identical*. In claim 7, the comparator is located on the *receiver side* and it compares the *output data* supplied by the *first data modification device* and the *second data modification device* via the data transmission path.

As to cited column 7, lines 33 to 44, of the MK reference, it does not disclose these features. The comparison in the MK reference is between “the signals appearing at the output of the input register ... to a signal composed of the *address allocated to the control device and of the declared end identifier*.” (MK, column 7, lines 35 to 39, emphasis added.) To the extent that the Office Action suggests that the “signal composed of the address allocated to the control device and the declared end identifier” is identical to the *output data* of the *second data modification device* of claim 7, it is respectfully submitted, that the signal of MK is merely the address and not the actual data, as in claim 7.

Accordingly, claim 7 is allowable, as is its dependent claim 8.

Independent claim 13 has features like those of claim 7, and it is therefore allowable for essentially the same reasons as claim 7.

Withdrawal of the anticipation rejections of claims 7, 8, and 13 is therefore respectfully requested.

Claims 9, 10, 14 and 15 were rejected under 35 U.S.C. § 103(a) as being obvious over the MK reference in view of U.S. Patent No. 6,470,012 to Nakatsugawa (“Nakatsugawa”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 9, 10, 14, and 15 ultimately depend from independent claims 7 or 13 and they are allowable for essentially the same reasons as their respective base claims, since the secondary Nakatsugawa reference does not cure -- and is not asserted to cure -- the critical deficiencies of the primary MK reference. For at least this reason claims 9, 10, 14, and 15 are allowable.

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious over the MK reference in view of U.S. Patent No. 4,852,680 to Brown et al., (“Brown”).

Claims 11 and 12 ultimately depend from independent claim 7 and they are therefore allowable for essentially the same reasons as independent claim 7, since the secondary Brown reference does not cure -- and it is not asserted to cure -- the critical deficiencies of the primary MK reference. For at least this reason claims 11 and 12 are allowable.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejections is therefore respectfully requested.

Accordingly, claims 7 to 15 are allowable.

New claims 16 to 24 do not add new matter and are supported by the application, including the Specification, as originally filed. Claims 16 to 24 ultimately depend from claim 7, and they are therefore allowable for the same reasons as claim 7. Additionally, each of claims 16 to 24 provides further features that are not disclosed or suggested by the applied references, as any review of the applied references makes plain. Accordingly, claims 16 to 24 are allowable.

In view of the foregoing, claims 7 to 24 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that claims 7 to 24 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

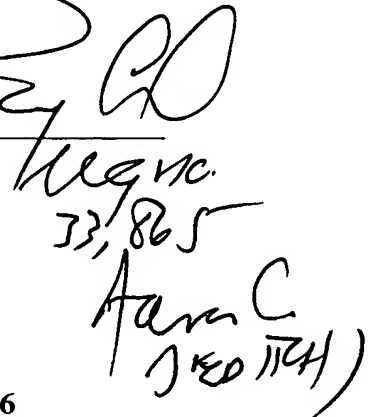
Dated: 10/26/2009

By: 

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646


Heine
33,865
Am C
(RED ITH)